

REMARKS

This is intended as a full and complete response to the Final Office Action dated January 12, 2006, having a shortened statutory period for response set to expire on April 12, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-13, 32, 35, 38, 41-44, 47, 50, 54-56, 64, 67, 70 and 73-75 remain pending in the application and are shown above. Claims 14-31, 33, 34, 36-37, 39-40, 48-49, 51-53, 57-63, 65-66, 68-69, 71-72 and 76-79 stand withdrawn by the Examiner. Claims 1-13, 32, 35, 38, 41-44, 47, 50, 54-56, 64, 67, 70 and 73-75 stand rejected. Reconsideration of the rejected claims is requested for reasons presented below.

Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 5-7, 9-13, 32, 35, 38, 41, 42, 44, 54-56, 64, 67, 70, 73 and 75 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the pre-grant publication '608 to *Smith, Jr., et al* (hereafter *Smith*). The Examiner asserts that *Smith* anticipated the claimed subject matter in Figures 3-5.

Applicant respectfully traverses this rejection.

Smith discloses tools for expanding downhole tubulars into each other or in an open hole (Abstract). *Smith* teaches a series of collets 82 extend between a stationary cone 72 held by a dog 74 and a movable cone 84 which is movable longitudinally driven by pistons 94, 96 and 98. The collets 82 move radially or expand/retract in response to the longitudinal movement of the movable cone 84 (Figures 3, and paragraph 0021). *Smith* further teaches that the locking assembly, i.e. the dog 74, can be released allowing the collets 82 to retract inwardly (paragraph 0022). However, *Smith* does not teach a locking assembly for locking an activating member in an activating position to maintain an expansion member in an extended configuration. Instead, *Smith* teaches that in the operating position, when the stationary cone 72 is locked by the dog 74, the expansion of the collets 82 may be adjusted to pass a tight spot.

Additionally, the Examiner indicates that the movable cone 84 of *Smith* relates to a body, the dog 74 of *Smith* relates to a locking assembly, and the collets 82 of *Smith*

relates to an expansion member. The Examiner does not indicate which element relates to an activating member. It reads that the Examiner may relate either a mandrel 64 or the stationary cone 72 of *Smith* to the activating member. However, the stationary cone 72 is not movable within the body (the movable cone 84), and the mandrel 64 does not urges the expansion member (the collets 82) towards the extended configuration, as asserted by the Examiner.

Therefore, *Smith* does not teach, show or suggest a tubing expansion tool comprising a body, at least one expansion member radially movably mounted on the body for movement towards an extended configuration describing an expansion diameter, an activating member movable within the body and having an activating position in which the activating member urges the expansion member towards the extended configuration and a locking assembly for locking the activating member in the activating position to maintain the expansion member in the extended configuration, as recited in claim 1 and claims dependent thereon.

Regarding claim 54, *Smith* does not teach each and every element as claimed. Especially, *Smith* does not teach providing a tubing expansion tool comprising a body, at least one expansion member movably mounted on the body, and an activating member for moving the expansion member, and locking the activating member using a locking assembly when the expansion member is in the extended configuration. Therefore, claim 54 and claims dependent thereon are believed to be allowable.

Withdrawal of this rejection is respectfully requested.

Claims 1-3, 5-7-13, 32, 35, 38, 41, 42, 44, 54-56, 64, 67, 70 and 73 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the pre-grant publication '446 to *Haugen et al* (hereafter *Haugen*).

Applicant respectfully traverses this rejection.

The Examiner asserts that the earlier effective filing date of *Haugen* constitutes *Haugen* as prior art under 35 U.S.C. 102(e). The Examiner further asserts that *Haugen* discloses the claimed subject matter in Figures 6, 7, and 10. Applicant submits that Figures 6, 7 and 10 of *Haugen* was first disclosed in provisional application serial No. 60/467,503 filed on May 2, 2003 which is later than September 10, 2002, the effective

filings date of the present application. Additionally, the parent patent application of *Haugen*, US Patent No. 6,708,767 filed on October 25, 2001, does not teach, show or suggest the subject matter of claims 1 and 54, and claims dependent thereon. Therefore, *Haugen* does not qualify as a reference under 35 U.S.C. 102(e). Withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith*, or *Haugen*.

Applicant respectfully traverses this rejection.

Smith and Haugen are discussed above. *Smith* does not teach each and every element set forth in claim 1, on which claim 4 is dependent. *Haugen* does not qualify as a reference under 35 U.S.C. 102(e). Claim 4 is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claims 43, 47 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith* or *Haugen Underhill* '410 (hereafter *Underhill*).

Applicant respectfully traverses this rejection.

Smith and Haugen are discussed above. *Underhill* discloses using the pin (444) to hold the expansion member (402) in a retracted position (solid lines) when moving the tool to and from a working position (Figure 18, and paragraph 44). *Underhill* does not teach locking the expansion member in the extended configuration as set forth in claim 1. The combination of *Smith* and *Underhill* does not teach, show or suggest the subject matter of claim 1, on which claims 43, 47 and 50 are dependent. Claim 43, 47 and 50 are believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

Claim 74 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith* or *Haugen* in view of WIPO document '766 to *Simpson et al* (hereafter *Simpson*).

Applicant respectfully traverses this rejection.

Smith and Haugen are discussed above. *Simpson* discloses methods and apparatus for shaping pipes, tubes, liners or casing at downhole locations. However,

Simpson does not teach locking an activating member for moving an expansion member when the expansion member is an extended configuration, as set forth in claim 54, on which claim 74 is dependent on. The combination of *Smith* and *Simpson* does not teach, show or suggest the claimed subject matter of claim 54, on which claim 74 is dependent. Claim 74 is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the Final Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Final Office Action.

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

William B. Patterson

William B. Patterson

Registration No. 34,102

PATTERSON & SHERIDAN, L.L.P.

3040 Post Oak Blvd. Suite 1500

Houston, TX 77056

Telephone: (713) 623-4844

Facsimile: (713) 623-4846

Attorney for Applicant(s)